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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/747,020	12/26/2000	Koichi Awano	001740	3284
23850 7590 01/18/2007 ARMSTRONG, KRATZ, QUINTOS, HANSON & BROOKS, LLP 1725 K STREET, NW SUITE 1000 WASHINGTON, DC 20006			EXAMINER COLBERT, ELLA	
			ART UNIT 3694	PAPER NUMBER

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/18/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/747,020	<b>Applicant(s)</b> AWANO, KOICHI	
	<b>Examiner</b> Ella Colbert	<b>Art Unit</b> 3694	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 October 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 2 and 4 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2 and 4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 December 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Claims 1, 2, and 4 are pending. Claims 1 and 4 have been amended in this communication filed 10/19/06 entered as RCE and Amendment.

#### ***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/19/06 has been entered.

#### ***Drawings***

3. The drawings are objected to under 37 CFR 1.83(a) because they fail to show in Figure 1 "n" and "Tn" as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several

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views of the drawings for consistency: Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: Figure 1, reference character(s) "4-6" and "T4 -T6" and Figure 3, reference character(s) "A, D, And E". Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Specification***

4. The Specification is objected to because Page 2, line 15 recites "can purchase goods amount of the prepaid card. There are ...". This line would be better recited as "can purchase goods for the amount of the prepaid card. There are ...". Page 6, line 14 recites "...; 1, 2, 3 .....n denotes ...". This line would be better recited "...; 1, 2, 3, 4, 5, and 6 denotes ...". Page 7, line 16 and Page 8, line 1 have a similar problem. Page 6, lines 14-16 recite "... terminal units T1, T2, T3 ..... Tn ;..., ..., ... terminal units T1, T2, T3 ,,,,,, Tn". These lines would be better recited "... terminal units T1, T2, T3, T4, T5, and T6 ;..., ..., ... terminal units T1, T2, T3, T4, T5, and T6". Page 7, line 17 and Page 8, lines 3 and 14 have a similar problem. Correction is required. See MPEP § 608.01(b).

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1 and 4 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: Claim 1, line 4 "... a false card" or stolen;". Suggestion for the last claim limitations: means for withdrawing cash using the prepaid card; means for processing the withdrawal of cash using the prepaid card making the processed prepaid card invalid.

Claim 4 has a similar problem. It should be established in the claim limitations in the claim language that when cash has been withdrawn using the prepaid card at an ATM,

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the prepaid card is processed and becomes invalid. It is unclear in the claims, specification, and drawings why the card becomes invalid by performing the above process. Does the card become invalid because the amount remaining on the card is withdrawn leaving a zero balance or does some other event occur? Clarification in the claim language and the specification is respectfully requested in order for the Examiner to understand what event occurs making the card invalid by using the prepaid card at an ATM and making a cash withdrawal.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 2, and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 6,012,635) Shimada et al, hereafter Shimada and (US 6,473,500 B1) Risafi et al, hereafter Risafi in view of (US 6,003,762) Hayashida.

As per claim 1, Shimada discloses, A card settlement system using a debit card comprising: means for using a debit card having an identification number and a money withdrawal function to issue a prepaid card after the identification number of the debit card is checked to see if the debit card is forged or stolen (col. 9, line 15-27). Shimada failed to disclose, means for transmitting settlement data corresponding to a price or

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charge to be paid by using said prepaid card from a store's bank with which a prepaid card usable store has an account to a settlement bank in which said prepaid card is issued. Risafi discloses, means for transmitting settlement data corresponding to a price or charge to be paid by using said prepaid card from a store's bank with which a prepaid card usable store has an account to a settlement bank in which said prepaid card is issued (col. 13, lines 53-62). Shimada and Risafi failed to disclose, means for remitting from said settlement bank to a store's account in said store's bank on the basis of said settlement data. Hayashida discloses, means for remitting from said settlement bank to a store's account in said store's bank on the basis of said settlement data (col. 5, lines 51-61, col. 8, line 56- col. 9, line 23). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have a means for remitting from said settlement bank to a store's account in said store's bank on the basis of said settlement data and to modify in Shimada because such a modification would allow Shimada to have an ATM terminal unit that writes the information about the amount the owner transfers between his bank deposit account and the multi-function IC card and to consummate the processing of the settlement data.

As per claim 2, Shimada failed to disclose, The card settlement system according to Claim 1, wherein said prepaid card does not store an amount of money having a cash function but stores credit grant information indicative of a usable amount. Risafi discloses, The card settlement system according to Claim 1, wherein said prepaid card does not store an amount of money having a cash function but stores credit grant information indicative of a usable amount (col. 13, lines 19-62). It would have been

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obvious to one having ordinary skill in the art at the time the invention was made to have said prepaid card to not store an amount of money having a cash function but stores credit grant information indicative of a usable amount and to modify in Shimada because such a modification would allow Shimada to provide a card that is more flexible than the cards typically available today.

As per claim 4, Shimada discloses, A card settlement system using a debit card including an ATM of a settlement bank, said ATM comprising: means for using a debit card having an identification number and a money withdrawal function to issue a prepaid card after the identification number of the debit card is checked to see if the debit card is forged or stolen (col. 9, lines 15-27). Risafi discloses, means for inserting a prepaid card having a balance into said ATM (col. 13, line 63-col. 14, line 19); means for inputting an identification number for the prepaid card (col. 14, lines 37-55). Shimada and Risafi failed to disclose, means for permitting withdrawal of money when said identification number of the prepaid card. Hayashida discloses means for permitting withdrawal of money when said identification number of the prepaid card is proper and for processing said prepaid card to an invalid state (col. 12, lines 27-46). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have a means for permitting withdrawal of money when said identification number of the prepaid card is proper and for processing said prepaid card to an invalid state and to modify in Shimada because such a modification would allow Shimada to have the capability to perform a validity check on the card to permit the execution of normal processing.



### **Conclusion**

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Hu (US 6990466) disclosed ATMs and a settlement credit card and debit card transaction.

### **Inquiries**

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741. The examiner can normally be reached on Monday, Tuesday, and Thursday, 5:30AM-3:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>.

Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

January 6, 2007

  
ELLA COLBERT  
PRIMARY EXAMINER